

**Response Under 37 C.F.R. § 1.116
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REMARKS

A. Background

Claims 1-40 were pending in the application at the time of the Office Action with claims 24-27 and 39 being withdrawn from consideration. Each of claims 1-23, 28-38 and 40 were rejected as being anticipated and/or obvious over cited prior art. By this response Applicant has amended claims 1, 4, 13, 18, 19, 28, 33, 37, and 40; cancelled claims 3, 5, 6, 17, 24-27, 29, 30, 35, 36 and 39; and added new claim 41. As such, claims 1, 2, 4, 7-16, 18-23, 28, 31-34, 37, 38, 40, and 41 are presented for the Examiner's consideration in light of the following remarks.

B. Proposed Claim Amendments

Applicant has herein amended claims 1, 4, 13, 18, 19, 28, 33, 37, and 40 and has added new claim 41. Claim 1 has been amended to incorporate the limitations of claims 3 and 5. Claim 4 has been amended to depend directly from claim 1 in view of the cancellation of claim 3. Claim 13 has been amended to address the rejection under 35 USC § 112 and to incorporate the limitations of claim 17. Claims 18 and 19 have been amended to correct inadvertent typographical errors. Claim 28 has been amended to incorporate the limitations of claim 30. Claim 33 has been amended to incorporate the limitations of claim 36. Claims 37 and 40 have been amended to change their dependency in view of cancellation of claims 35 and 3. New claim 41 is the combination of prior pending claims 1 and 7.

In view of the foregoing, applicant respectfully submits that all of the claim amendments are supported by the prior pending claims. As such, applicant respectfully submits that the amendments do not raise new issues that will require a supplemental search and that the claim amendments place

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the claims in better condition for allowance. Accordingly, applicant respectfully submits that the claim amendments should be properly entered under 35 USC § 1.116 and entry thereof is respectfully requested.

C. Rejection on the Merits

With regard to paragraphs 1-5 of the Office Action, applicant confirms that in response to the oral restriction requirement applicant elects claims 1-23, 28-38 and 40 for prosecution on the merits. As such, applicant has herein claimed claims 24-27 and 39 which were the non-elected claims.

Paragraphs 6 and 7 of the Office Action objected to claim 13 for lacking antecedent basis for the term "the backing." Applicant has herein amended claim 13 to remove the term and thus withdrawal of the rejection is respectfully requested.

Paragraphs 8-21 of the Office Action rejected claims 1, 2, and 10-12 under 35 USC §102(b) as being anticipated by U.S. Patent No.6,520,926 to Hall while claims 3-6, 9, 13-18, 20, 21, and 40 were rejected under 35 U.S.C. § 103(a) as being obvious over the Hall patent. Applicant respectfully traverses the rejections.

In part, claim 1 has been amended to incorporate the limitations of claim 3. As such, claim 1 now recites in part "a plurality of spaced apart pressure projections extending from the backing toward the channel, the pressure projections being woven into the woven fabric sheet." In discussing claim 3, the Office Action concedes that "Hall does not disclose a compression garment and recited in claim 1, wherein the backing comprising the woven fabric sheet and the pressure projections are woven into the woven fabric sheet." (Office Action page 5.) The Office Action, however, goes on to state that

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applicant stated on page 7, [0022] that the projection can be separately mounted onto backing such as by stitching, tape, adhesive, Velcro, fastener, or the like. Therefore, how the projections are mounted on the backing does not seem to be critical. Hall discloses the microdots are "joined under heat" to the backing (col. 7, lines 46-48), where "joined" is considered broader recitation of securing means. With lack of criticalities regarding a particular securing means is considered superior than others, it would have been obvious to consider the securing means of the projections to the backing as disclosed by Hall is considered to meet claimed limitation.

Office Action pages 5-6. Applicant respectfully disagrees with the findings of the Office Action on several grounds.

First, with reference to column 7, lines 46-48, the Office Action asserts that Hall discloses the microdots are "joined under heat." Applicant respectfully disagrees. Column 7, lines 48-48 of the Hall patent specifically states that "the silicone imprinted laminate 97 may also be joined under heat and pressure with a release-coated protective backing prior to winding on rolls 100. The backing may be removed after complete cure of the silicone." (Emphasis added.) Applicant respectfully submits that column 7, lines 46-48 of the Hall patent has nothing to do with how silicone microdots 23 are mounted on laminate 79. Rather, this section of the specification referenced in the Office Action is discussing that after the microdots 23 are positioned on laminate 79, a "release-coated protective backing" can be mounted on the silicone imprinted laminate 97 prior to winding of the laminate on rolls 100. It is the "backing" that is joined to the laminate 97 under heat no the microdots 23. The protective backing is used to prevent the silicone microdots 23 from causing the roll to stick together as the silicone cures. Thus, the backing may be removed after complete cure of the silicone.

In contrast to the assertion made in the Office Action, silicone microdots 23 are clearly mounted to laminate 79 "by a process such as graver printing." The process of using graver printing to attach microdots 23 to laminate 79 is clearly disclosed at column 7, lines 1-40. In general,

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microdots 23 are deposited on laminate 79 by rolling graver cylinder 89 having small recesses 95 filled with silicone 85 over laminate 79 so that small dots of silicone are deposited on laminate 79.

As previously discussed, the Office Action clearly concedes that the Hall patent does not disclose pressure projections being “woven” into the woven fabric sheet as required by claim 1. Furthermore, because the Hall patent teaches that microdots 23 are printed onto laminate 79 in the form of a liquid, the Hall patent clearly does not teach or suggest the microdots being “woven” into laminate 79 nor can applicant comprehend how a liquid composition could be woven into laminate 79. In contrast, in the present invention fibers can be woven into the fabric sheet so that the woven fibers form the pressure projections such as in the formation of corduroy material. No such weaving is disclosed, suggested, or enabled by the Hall patent. In addition, as discussed below with regard to claim 4, having the pressure projections woven into the backing, such as in the form of corduroy material, can have a number of benefits over alternative approaches.

The Office Action further seems to assert that because the present application discloses a variety of alternative methods for mounting pressure projections on a material, and because the Hall patent discloses a method for attaching microdots 23 which allegedly covers one of the methods disclosed in the patent application, therefore all methods of the present invention are obvious over the Hall reference. Applicant respectfully disagrees. Here the Office Action is clearly using impermissible hindsight based on the applicant’s own teachings in the specification to support that the claimed invention is obvious. It is well established that the “teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in prior art and not based on applicant’s disclosure. MPEP § 706.02(j). See also MPEP § 2142 which further discusses that “knowledge of applicant’s disclosure must be put aside in reaching [the]

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determination” of obviousness, and that “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” In the present case, applicant’s alternative embodiments disclosed in the specification of how different materials can be attached to the backing are irrelevant in establishing whether the structure of claim 1 is obviousness over the Hall patent. Rather, the relevant issue is whether the Hall patent discloses the claimed limitation. Which, as conceded in the Office Action, it does not.

In view of the foregoing, applicant respectfully submits that the Office Action fails to establish a proper *prima facie* obviousness rejection of claim 1 which incorporates the limitations of claim 3 and that the prior art does not disclose or suggest “the pressure projections being woven into the woven fabric sheet,” as recited in claim 1.

Claim 1 has also been amended to incorporate the limitations of claim 5. As such, claim 1 also recites in part “the plurality of spaced apart pressure projections comprising a plurality of an elongated ribs bounding a plurality of spaced apart recessed flow pass.” With regard to claim 5, the Office Action states that

Hall does not disclose a compression garment as recited in claim 1, wherein the pressure projections comprise a plurality of elongated ribs. However, applicant has not establish criticalities why elongated ribs are favored over spread apart projections as disclosed by Hall. It is well known in the art that pressure projections can come in a wide variety of sizes and shapes. Therefore, it would have been obvious to consider a particular pressure projection required by the applicant as a matter of design choice.

Office Action, page 6. Again, applicant respectfully disagrees with the Office Action.

As discussed in the present application, in one embodiment the present invention can be used in the treatment of lymphedema. The compression garment is designed so that the pressure projections produce relative high and low pressure areas on an appendage. As a result, unwanted

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fluid naturally flows out of the appendage through the low pressure areas. It is believed that by having pressure projections in the form of elongated ribs that extend along the length of the compression garment and thus along the length of the appendage that these elongated ribs form natural linear flow paths that optimize the flow of the unwanted fluid from the appendage. Thus, although pressure projections can come in a variety of different configurations, it is believed that there are unique benefits in having the pressure projections in the form of elongated ribs. Since the Hall patent is clearly not for use in association with lymphedema and provides no disclosure or suggestions with forming the pressure projections in the form of elongated ribs, applicant respectfully submits that the Hall patent does not disclose or suggest, **“the plurality of spaced apart pressure projections comprising a plurality of elongated ribs bounding a plurality of spaced apart recessed flow paths,”** as recited in claim 1. In view of the foregoing, applicant respectfully submits that claim 1 is neither anticipated nor obvious over the cited prior art.

Claims 2, 4, and 9-12 depend from claim 1 and thus incorporate the limitations thereof. As such, applicant respectfully submits that claims 2, 4, and 9-12 are allowable over the prior art for at least the same reasons as discussed above with regard to independent claim 1.

Furthermore, applicant respectfully submits that many of dependent claims are also independently distinguishable over the cited prior art. For example, claim 4 recites “the interlayer comprises a corduroy fabric.” With regard to claim 4, the Office Action states that

Hall does not disclose a compression garment as recited in claim 3 wherein the inner layer comprises a corduroy fabric. However, applicant stated on page 7 [0022] that the backing can comprise any breathable, woven fabric material or any other type of breathable material such as perforated polymeric sheets. Therefore, Hall’s inner layer of fabric construction (col. 5, lines 45) would consider meeting the claimed invention.

Office Action, page 6.

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Again applicant respectfully submits that this rejection is clearly improper in that it is using impermissible hindsight based on applicant's teachings in the specification to support the obviousness rejection. An obviousness rejection cannot be based on applicant's disclosure in the specification. Although applicant discloses a number of different types of materials that can be used to form the pressure projections, such teachings are irrelevant with regard to establishing an obviousness rejection. Furthermore, the fact that applicant discloses a number of embodiment does not mean that selected embodiments do not have specific advantages and benefits over other embodiments. By way of example and not by limitation, corduroy fabric has distinct advantages over perforated polymeric sheets and over Hall's silicone microdots in that all of the corduroy fabric is breathable whereas polymeric sheets and silicone microdots are not breathable. Furthermore, corduroy fabrics are soft and comfortable, produce desired flow channels which naturally result from the ribs formed on the corduroy, can be easily washed and cleaned, and facilitate easy manufacture and assembly of the compression garment. In view of the foregoing, applicant respectfully submits that the Office Action fails to establish a proper *prima facie* obviousness rejection with regard to claim 4 and that claim 4 is clearly not disclosed or suggested by the cited prior art.

Claim 9 recites "a plurality of compression straps secured to or encircling the garment body."

The Office Action states that

Hall does not disclose a compression garment as cited in claim 1, further comprising a plurality of compression straps, however teaches the support may includes fasteners such as hooks, zippers, buttons, and the like (column 7, lines 55-57), and straps are conventionally known in the art as a form of fastener used to fasten pressure sleeves and orthopedic braces. Therefore, it would have obvious to consider fasteners taught by Hall as an alternative or equivalent securing means.

Office Action, page 6. Applicant respectfully disagrees.

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The Hall patent specifically states “the present invention is directed to an improved compression support sleeve constructed to stay comfortably in place during strenuous activity without the need for stays or straps and without causing irritation of the underlying skin.” (Col. 1, lines 5-8). The Hall patent specifically states that the support sleeve is specifically designed to operate without the use of “straps.” Accordingly, because the Hall patent teaches away from using straps, applicant respectfully submits that it would not be obvious to modify the Hall patent to include “a plurality of compression straps secured to or encircling the garment body,” as recited in claim 9. For substantially the same reasons, applicant also respectfully submits that the Hall patent does not disclose or suggest “a tubular compression sock comprised of a resiliently stretchable material that can be selectively pulled over the garment body,” as recited in claim 40.

With regard to claim 40, the Office Action also states that

Hall does not disclose a compression garment as recited in claim 3, further comprising a tubular compression sock comprised of a resiliently stretchable material that can be selectively pulled over the garment body, however applicant stated on page 14, [0038] that sock, one or more compression straps, inflatable bladders are considered [means] for providing constricting at least a portion of the body. As discussed above, fastening means disclosed by Hall is capable of selectively constricting the sleeve.

Office Action, page 7. Again, applicant respectfully submits that the rejection set forth in the Office Action is improper as it relies on applicant’s teachings in the specification to support the obviousness rejection. Applicant submits that the Hall patent does not disclose or suggest positioning a compression sleeve over the garment nor, in view of the teaches in Hall, is there any motivation to apply such a compression sleeve.

Turning to independent claim 13, applicant also respectfully submits that the rejection of claim 13 as set forth on page 7 of the Office Action is also improper in that it uses impermissible

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hindsight by using applicant's teachings in the specification to support the obviousness rejection. Furthermore, for substantially the same reasons as discussed above with regard to claim 9 and claim 40, applicant respectfully submits that the Hall patent does not disclose "means for constricting at least a portion of the body when the body is in the at least substantially tubular configuration," as recited in claim 13. That is, the Hall patent is specifically designed so that straps and other compression structures are not required on the support sleeve. Nor is there any motivation to add such means for constricting the support sleeve of the Hall patent.

Furthermore, claim 13 has now been amended to recite the limitations of claim 17. As such, claim 13 now recites in part "the pressure projections comprising brushed cotton, a brushed polymeric material, woven fabric, or piled fabric secured to the fabric sheet." The Office Action uses the same argument to support the obviousness of claim 17 that was used to support the obviousness of claim 3. As such, applicant again respectfully submits that the obviousness rejection of claim 13 is both improper and unsupported for the same reasons as previously discussed with regard to claim 1 combined with claim 3. Specifically, the Hall patent discloses positioning silicone microdots 23 on laminate 79. Silicone is used because it is "tacky" and thus helps to prevent movement of the compression sleeve. See Hall patent col. 3, lines 52-55. The Hall patent clearly does not disclose or suggest pressure projections comprising "brushed cotton, a brushed polymeric material, woven fabric, or piled fabric." Likewise, applicant respectfully submits that there is simply no motivation to replace the tacky silicon microdots 23 of Hall with the claimed materials. Furthermore, applicant submits that use of applicant's teachings in the specification of the present application to support an obviousness rejection is improper. In view of the foregoing, applicant respectfully submits that claim 13 is neither anticipated nor obvious over the cited prior art.

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Claims 14-16, 18, 20, 21, and 22 depend from claim 13 and thus incorporate the limitations thereof. As such, applicant respectfully submits that claims 14-16, 18, 20, 21, and 22 are distinguishable over the prior art for at least the same reasons as discussed above with regard to claim 13.

Furthermore, applicant respectfully submits that many of the dependent claims are also independently distinguishable over the cited prior art. For example, for substantially the same reasons as previously discussed, applicant respectfully submits that the Hall patent does not disclose or suggest "wherein the pressure projections are woven into the woven fabric sheet," as recited in claim 14, "wherein the inner layer comprises a corduroy fabric," as recited in claim 15, "the means for constricting at least a portion of the body comprises a plurality of compression straps secured to or encircling the garment body" as recited in claim 20 or, "the means for constricting at least a portion of the body comprises a resiliently stretchable tubular sock that is selectively pulled over the body," as recited in claim 21.

Page 8 of the Office Action states that claims 7, 8, 19, 21, 28-38, and 40 are rejected under 35 USC § 103(a) as being obvious over the Hall patent in view of U.S. Patent No. 6,656,141 to Reed. Applicant respectfully traverses these rejections.

Claims 7 and 19 recite "a cover layer mounted to the inner layer so as to directly cover the pressure projections." The Office Action states that because the Reed patent teaches placing a lining cover over the pressure projection fingers disclosed in the Reed patent that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sleeve of Hall in view of Reed in order to add a cover layer for the purpose of allowing comfort." Office Action, page 8. As previously discussed, the primary purpose for having silicon microdots 23 in the

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Hall patent is that they are tacky so that they stick to the skin of the user and thus prevent movement of the support sleeve. See Hall patent col. 3, lines 52-55. As such, applicant respectfully submits that it would clearly not be obvious to add a cover over microdots 23 of the Hall patent because the covered microdots would then no longer stick to the skin of the user. Accordingly, because applying a cover over the microdots of the Hall patent would destroy the intended function and purpose of the invention in the Hall patent, applicant submits that it would not be obvious modify the Hall patent as suggested in the Office Action. As such, applicant respectfully submits that the Office Action fails to establish a proper *prima facie* obviousness rejection with regard to claims 7 and 19 and thus withdrawal of the rejection is respectfully requested. Claims 8 and 21 depends from claim 7 or 13 and thus are allowable for at least the same reasons as discussed with regard to claim 7 and claim 13.

With regard to claim 28, claim 28 has been amended to incorporate the limitations of claim 30. Specifically, claim 28 now recites that “the inner layer being comprised of a corduroy material.” Initially, applicant respectfully submits that claim 30 was rejected in the Office Action based on applicant’s own teachings in the specification. Applicant again respectfully submits that this rejection is improper as the rejection relies on impermissible hindsight based on applicant’s own teachings. Furthermore, for substantially the same reasons as previously discussed with regard to claim 4, applicant respectfully submits that the prior art does not disclose or suggest the use of a “corduroy material” and that the use of corduroy material produces a number of unique advantages in the present invention.

Applicant also respectfully submits that because the Hall patent is specifically designed so as to avoid the need of external straps, applicant respectfully submits that it would not be obvious to modify the teachings of the Hall patent to apply “a plurality of compression straps” or “a tubular

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compression sock,” as also recited in claim 28. In view of the foregoing applicant respectfully requests that the rejection of claim 28 be withdrawn.

Claims 31 and 32 depend from claim 28 and thus incorporate the limitations thereof. As such, applicant respectfully submits that claims 31 and 32 are allowable over the cited prior art for at least the same reasons as discussed above with regard to claim 28.

Applicant respectfully submits that independent claim 33 is also allowable over the cited prior art for substantially the same reasons as discussed above with regard to claim 28. Specifically, applicant respectfully submits that the prior art does not disclose or suggest “the body having an inner layer comprised of a corduroy material” nor does it disclose or suggest “a means for constricting at least a portion of the body, the means for constructing comprising: a plurality of compression straps” or “a tubular compression sock,” as recited in claim 33. In view of the foregoing, applicant respectfully requests that the rejection with regard to claim 33 be withdrawn.

Claims 34, 37, and 38 depend from claim 33 and thus incorporate the limitations thereof. As such, applicant respectfully submits that claims 34, 37, and 38 are allowable over the cited prior art for at least the same reasons as discussed above with regard to claim 33.

Page 10 states that claims 22 and 23 are rejected under 35 USC § 103(a) as being obvious over the Hall patent in view of U.S. Patent No. 6,254,554 to Turtzo. Claims 22 and 23 depend from claim 13 and thus incorporate the limitations thereof. Applicant submits that the Turtzo patent does not cure the deficiencies of the Hall patent previously discussed with regard to 13. As such, applicant submits that claims 22 and 23 are allowable for at least the same reasons as discussed above with regard to claim 13.

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Finally, applicant has herein added new claim 41. New claim 41 is a combination of original claims 1 and 7. As such, applicant respectfully submits that new claim 41 is allowable over the cited prior art for at least the same reasons as previously discussed with regard to claim 7.

No other objections or rejections are set forth in the Office Action.

D. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited prior art. Most notably, Applicant submits that many if not all of the dependent claims are independently distinguishable over the cited prior art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited prior art.

In view of the foregoing, Applicant respectfully requests the Examiner's reconsideration and allowance of claims 1, 2, 4, 7-16, 18-23, 28, 31-34, 37, 38, 40, and 41 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 4th day of October 2005.

Respectfully submitted,



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